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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,657	05/29/2001	Peter Robert Bernstein	133087.01701(Z70402-1PUS)	4679
53286 7590 08/14/2008 Pepper Hamilton LLP 400 Berwyn Park 899 Cassatt Road Berwyn, PA 19312-1183				
EXAMINER DESAL, RITA J				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
08/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/806,657

**Applicant(s)**

BERNSTEIN ET AL.

**Examiner**

Rita J. Desai

**Art Unit**

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: 5/20/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-17 have been cancelled.

New Claims 18-26 are pending.

Response to the arguments:-

Applicants argue that the claims as amended are not obvious and that the Office has mistakenly made the rejection since all the substituents are not taught in the reference.

Applicants amended claims have to have 2 substituents on the naphthyl ring .

Hence the rejection under 35 USC 103 has been withdrawn.

The rejection under 35 USC 112 first para , however still stands.

Applicants have not provided any arguments except by saying that the amended claims are enabled. That is not so. Applicants claims are not limited to R4-R6, to be H, alkyl, alkoxy or cyano X1 and X2 to be halogen . The amended claims still have a large scope of various groups R4-R6 and for the various R7 substituents.

New rejection

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

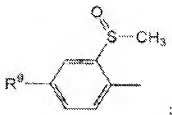
Claims 18-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6365602. Although the conflicting claims are not identical, they are not patentably distinct from each other because



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20. (new) A compound according to claim 18 wherein:  
 $R^1$  is methylsulfonyl, amino, methylamino or dimethylamino; and  
 $R^2$  is hydrogen.

21. (new) A compound according to claim 18 wherein:  
 $R^1$  is



$R^2$  is hydrogen; and

$R^2$  is hydrogen,  $C_{1-6}$ alkoxy, halo,  $C_{1-6}$ alkylsulfinyl, or carboxy

22. (new) A compound according to claim 18 wherein:

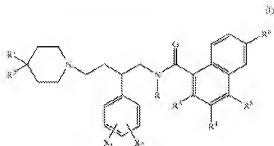
The patent US '602 discloses the same core.

$R_6$  substituent can be a H.  $R_1$  is a phenyl substituted by a  $S=OCH_3$  group.

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What is claimed is:

1. A compound of the formula (I):



wherein:

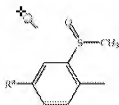
R is alkyl;

R<sup>1</sup> is optionally substituted phenyl, 2-oxo-tetrahydro-1 (2H)-pyrimidinyl, or 2-oxo-1-piperidinyl;R<sup>2</sup> is hydrogen, alkoxy, alkanyloxy, alkoxycarbonyl, alkanylamino, acyl, alkyl, carbamoyl, N-alkylcarbamoyl, N,N-dialkylcarbamoyl where the alkyl groups are the same or different, hydroxy, thioacyl, thiocarbamoyl, N-alkylthiocarbamoyl, or N,N-dialkylthiocarbamoyl where the alkyl groups are the same or different;X<sub>3</sub> and X<sub>4</sub> are independently hydrogen or halo, provided that at least one of X<sub>3</sub> or X<sub>4</sub> is halo; andR<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, and R<sup>6</sup> are independently hydrogen, cyano, nitro, trifluoromethoxy, trifluoromethyl, or alkylsulfonyl, provided that at least one of R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, and R<sup>6</sup> is not hydrogen;

or a pharmaceutically acceptable salt or an in vivo hydrolyzable precursor thereof.

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5. A compound according to claim 1 wherein R<sup>1</sup> is:



wherein R<sup>\*</sup> is hydrogen, C<sub>1-6</sub>alkoxy, halo, C<sub>1-6</sub>alkylsulfinyl or carboxy.

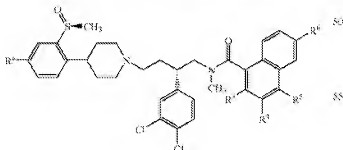
6. A compound according to claim 1 wherein R<sup>1</sup> is phenyl and any orthoethylsulfinyl substituent has the (S)-configuration.

7. A compound according to claim 1 wherein R<sup>1</sup> is 2-oxatetrahydro-1H(2H)-pyrimidinyl.

8. A compound according to claim 1 wherein R<sup>1</sup> is 2-oxo-1-piperidinyl.

9. A compound according to claim 1 wherein R<sup>2</sup> is hydrogen.

10. A compound according to claim 1 which is:



Thus a very closely related genus of compounds are claimed.

Thus it is an Obvious type of Double Patenting.

### Conclusion

Claims 18-26 stand rejected.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

R.D.  
August 7, 2008